REMARKS

As required by the Examiner, the Abstract of the Disclosure satisfying the requirements of U.S. practice is provided in the Response.

As to the Content of Specification, comments of the Examiner, a Substitute Specification showing all required subtitles accompanies the Response. The Substitute Specification has been provided only to accommodate the specific comments of the Examiner provided on pages 2 and 3 of the Office Action. A mark-up version of the application is also attached. Applicant respectfully considers that there is no new matter is introduced into the application by the substitute specification.

In the Outstanding Office Action Claims 1-8 and 12-14 have been rejected under 35 U.S.C. Section 101 because, in the opinion of the Examiner, the claims do not fall within the four patentable statutory classes of Section 101.

Applicant has amended claims of the application, so as to recite "a browser program <u>executed on a computer and stored on a computer readable medium</u>". The amendment clearly places the claims currently of record in the application within one of the four statutory classes.

MPEP 2106 discloses the USPTO Guidelines for Patentability ("the Guidelines"). The applicable portion of the Guidelines reads, "35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter."

Currently amended claims claim the limitation of executing a browser program on a computer and storing the browser on a computer readable medium. As the present claims are directed to either a process or machine, the claims fall within a statutorily acceptable category. Therefore, the present amendment should overcome the Section 101 rejection provided in the present application.

Still further, the Guidelines state that, "[t]he subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is **limited to** abstract ideas, laws of nature and natural phenomena." Thus, if the claimed invention is not in one of these three categories, absent an additionally created judicial exception, the claims are allowable.

Applicant claims instructions derived from identified data tags and visual output of such instructions. Clearly, this operation is not a law of nature or natural phenomena because manipulation of data tags does not occur in nature.

With regard to the judicially created exception for unpatentability of abstract ideas, according to the Court of Appeals for the Federal Circuit an abstract idea is only unpatentable when disconnected from a useful result. "Unpatentable mathematical algorithms are identifiable by showing they are merely abstract ideas constituting disembodied concepts or truths that are not 'useful'... [T]o be patentable an algorithm must be applied in a 'useful' way. . . [by] produc[ing] 'a useful, concrete and tangible result." *AT&T Corp v. Excel Communications Inc.* 172 F. 3d 1352 (Fed. Cir. 1999). Only the final result of the claimed invention need be useful, concrete and tangible. *In re Grams*, 888 F.2d 835, 839 (Fed. Cir. 1989). This test was based upon Supreme Court guidance given in Diamond v. Diehr, 450 U.S. 175 (1981) in which the Court held that while an abstract idea itself was not patentable, an implementation of an abstract idea was patentable.

Independent claims 1 and 12 claim a browser program on a computer readable medium, identifying tags and operating on these tags resulting in an output to a visual display. The method as recited in the claim language is useful for the display or use of data in the HTML tags. Thus, a useful result is claimed. This result is concrete because the result can be readily assured and is repeatable to produce substantially the same result each time, and the result is tangible because it is not abstract.

While the Board of Patent Appeals and Interferences (BPAI) has recently rejected much of the Guidelines in *Ex parte Bilski* (Appeal No. 2002-2257), such a rejection should not affect the outcome of the present application. *Bilski* involved "'non-machine-implemented' method claims ... broad enough to read on performing the steps without any machine or apparatus." The court in *Bilski* further stated that where there is "transformation of data by a machine" then *AT&T Corp v. Excel Communications, Inc.* is controlling.

Therefore, the above analysis with regards to a useful result provides the correct test to apply for patentability of the claims in this application. The claims of the present application, and specifically, independent claims 1 and 12, require a machine or apparatus and therefore are patentable under *Bilski* because the *AT&T* test is controlling and supports patentability of the presently presented claims. The Office Action acknowledges that the claim language teaches a software program. Further, as claimed, this software program requires at least a computer readable medium, a device to carry out the instructions, and generation of visual output. The claims are tied to the apparatus in such a way as to require the apparatus in order to be practiced.

For example, an apparatus such as a computer capable of carrying out instructions written in computer code and a video card are typically required to practice the invention.

The code is physically transformed from one form to another, requires a machine to do so, and has a useful, concrete and tangible result under the test as supported by *AT&T* and *Bilski*.

Therefore, in view of the amendments and arguments presented above, it is the Applicant's position that the Section 101 rejection of the claims currently of record in the application should be withdrawn.

Claims 1 and 12 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection appears to be moot in view of the claims amendment provided on the Response.

In the Office Action, Claims 1-5, 7, 8 and 12-14 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,266,681 to Guthrie.

With respect to Claim 1, the Examiner argues that Guthrie teaches a browser program which, when executed by a suitable device, causes the device to carry out the steps of the method of the invention. Applicant respectfully disagrees with this position of the Examiner.

examining data received as a page comprising page data and mark up language tags and identifying the mark up language tags (col. 1 lines 41-59);

analyzing the identified tags to derive instructions and generating a visual output derived from the page data based on instructions derived from the identified tags (col. 1 line 60 – col. 2 line 21, abstract); and

carrying out further operations based on instructions derived from the identified tags and not derived from the page data (col. 3 lines 30-41). Applicants respectfully disagree with this position of the Examiner.

In the opinion of the Applicant, Guthrie does disclose a web browser program which examines web pages including, HTML tags, identifies the HTML tags and generates a visual output based upon the page data and the HTML tags. It should be also noted that Guthrie does not disclose further step of claim 1 of carrying out further operations based on instructions derived from the identified tags and not derived from the page data.

The Guthrie disclosure relates to a method in which an injection mechanism is located between a web browser and servers sending web pages to the browser, so that the injection mechanism can install interceptor code into each document or web page sent to the web browser. This is shown in the example of Figure 4 where the interceptor code 402 is located between the web browser 401 and the server 403, so that document requests from the browser to the server and documents sent from the server to the browser must both pass through the interceptor code. The text referred to by the Examiner at column 3 lines 30-41 of Guthrie describes the function of an injection mechanism installing interceptor codes in web pages and the purpose of the installed code. However, this is not part of the functuality of the web browser of Guthrie. This is because in the reference the web browser is entirely separate from the interceptor code. The web browser disclosed in Guthrie is a conventional web browser having the functions as discussed in the prior art part of the present application.

It is explained in the Guthrie reference that "The HTML format is a document mark up language" and that "HTML defines tags for specifying how to interpret the text and images stored in a HTML document", see column 1 lines 48-252. It is

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explained in the text referenced by the Examiner (at column 3 lines 30-41) that the injection mechanism installs the interceptor code which inserts extra HTML code into HTML documents being sent from the server to the web browser. It must be understood that the injection of code into the HTML document is carried out by the injection mechanism/interceptor code and not by the web browser itself. From the point of view of the web browser, the injected code which has been added to web page (HTML document) by the injection/interceptor code is indistinguishable from the code of the original web page.

This is also explained in the Abstract of Guthrie, reference that "the injection mechanism installs interceptor code as a proxy server between a client browser and a server". In other words, the web browser perceives the interceptor code as the server acting as a source of the web pages sent to the web browser.

Thus, the general approach of Guthrie is to intercept web pages before they are received by web browser and to inject additional code into the web pages in order to change the displayed web pages, which are displayed by the web browser. There is no suggestion in Guthrie that the functionality or operation of the web browser itself should be changed compared to a normal web browser. The change to a conventional system proposed by Guthrie is the addition of the novel injection mechanism/interceptor code intended to change the content of web pages before they are supplied to the web browser.

Accordingly, it is respectfully submitted that the feature of the current claim 1 of a web browser program carrying out further operations based on instructions derived from identified mark up language tags and not derived from page data is not disclosed in the Guthrie reference.

Further, the main feature of the invention of Guthrie is the adding of an injection mechanism/interceptor code separate from the web browser and not changing the web browser itself. Thus, there would be no reason for the skilled person after reading Guthrie to consider changing a known web browser to provide the features of claim 1 currently of record in the application. This is because Guthrie does not propose making any changes or improvements to the web browser program at all.

Accordingly, in the opinion of the Applicants, claim 1 currently of record is new and not obvious over the Guthrie reference.

As to Claim 2, the Examiner argues that Guthrie teaches browser program in which the visual output derived from the page data s suitable for display in a display region of a visual display unit and the further operations define the size of the display region or elements to be displayed on the visual display unit outside or overlaying the display region (col. 2 lines 11-21). Applicant also disagrees wit this position of the Examiner.

The identified text of Guthrie describes that the web browser displays the HTML document on a display screen "as specified by the HTML tag". The preceding text at column 1 lines 38 - 60 discussing web pages and HTML explains that HTML tags define paragraph formats, emboldening and underlining, adding images to documents and formatting underlining text.

Accordingly, the skilled person will understand the wording referenced by the Examiner as relating to the document being displayed "as specified by the HTML tags" as meaning that the formatting and appearance of the displayed documents will be as specified by the HTML tags. There is nothing anywhere in Guthrie to disclose the possibility of the size of the display region or elements to be displayed on the

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visual display unit outside or overlaying the display region being controlled by the web browser program based upon instructions from tags as recited in claim 2 currently of record. It should be noted only that the appearance of the displayed document is controlled by instructions in HTML tags.

Accordingly, Applicant respectfully considers that claim 2 is new not obvious over the Guthrie reference.

With respect to Claim 3, the Examiner indicates that Guthrie teaches a browser program in which the visual output derived from the page data can be generated by one or more functional sections of the device and other operations include sending instruction to other functional sections of the device or to the other devices (col. 6 line 41 – col. 7 line 6). Applicants respectfully disagree with this rejection of the Examiner as well.

With respect to Claim 4, the Examiner argues that in Column 1, lines 41-59, Guthrie's teaches a browser program in which the other operations include the display of the text identified by the tag. (Column 1, lines 41-59) In actuality, the section of the Guthrie patent cited by the Examiner discusses the display of web pages. It is discussed in this section that "HTML defines tags for specifying how to interpret the text and images stored in HTML documents". Then Guthrie goes on to identify specific examples of tags such as defining paragraph formats, emboldening and underlining text, adding images and formatting and underlining text.

All of these examples are of HTML tags controlling the display of text with an appearance, format or layout being controlled by the HTML tag. There is nowhere in the Guthrie reference provided any suggestion of the possibility that the text which is displayed should be text identified by the tags, as required by claim 4.

That is, claim 4 specifies the display of text identified by the tags while Guthrie discloses only the display of text in a format identified by HTML tags.

Accordingly, it is the Applicants' position that claim 4 currently of record on the application is new and unobvious over the prior art.

The Examiner also argues that claim 5 is also not new over the Guthrie patent (Sec lines to 41 – 59 of Column 1). As explained on the identified text of the Guthrie patent it discloses only that the text included in a HTML document is displayed in a manner or format as defined in the HTML tags. There is no disclosure in Guthrie of a web browser displaying text derived from mark up language tags as required by claim 5.

Accordingly, claim 5 should be new and unobvious over the Guthrie patent.

In the Office Action, Claim 6 has been rejected under 35 U.S.C. 103(a) as being obvious over Guthrie, U.S. Patent No. 6,266,681 in view Thomsen, U.S. Patent No. 6,862,596.

In this respect, the Examiner argues that Guthrie fails to explicitly disclose a browser program in which the other operations include requesting a smart card reader to carry out a transaction with a smart card.

However, Thomsen discloses a browser program in which the other operations include requesting a smart card reader to carry out a transaction with a smart card. (col. 4 lines 35-48)

Therefore, Examiner concludes that it would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Guthrie and Thomsen because it provides an efficient way of paying for online services through a web page.

Applicants respectfully consider that it is accepted in the Office Action that claim 6 is a new over Guthrie because Guthrie does not disclose any interaction between a browser program and smart card reader. The Examiner refers to Thomsen (US6862596) as disclosing a browser program in which other operations which include requesting a smart card reader to carry out a transaction with a smart card. Thus, the Examiner concludes that claim 6 would be obvious to someone reading Guthrie and Thomsen together.

The identified text at column 4 lines 35- 48 of the Thomsen patent species only that client computers 102 which include a browser program module may also include other elements such as smart cards.

The suggestion in the Thomsen patent that a host computer hosting a web browser program may include a smart card is not sufficient to disclose or suggest to the skilled person the browser program according to claim 6.
It should be noted that in Claim 6, the other operations (previously defined as operations based on instructions derived from mark up language tags and not page data) include requesting a smart card reader to carry out a transaction with a smart card.

Accordingly, it has been demonstrated hereinabove that claim 6 is not made obvious by the combined teachings of Guthrie and Thomsen.

As to claim 7, it is indicated in the Office Action that this claim is not new over Guthrie and (column 15 line 51 to column 16 line 12 is referred). Applicant respectfully considers that the identified text at (column 15 line 51 to column 16 line 12) of Guthrie discusses a browser executing "injected code placed before an existing <FRAMESET> tag" and "injected code placed after the <BODY> tag in order to selectively generate an injectable component. Thus, it is clearly defined that the injected code executed by the browser is injected into the HTML document itself and not an HTML tag. Accordingly, since the HTML text does not relate to actions taken by a web browser program in response to HTML tags it cannot disclose a web browser carrying out other operations. These operations are previously defined in claim 1 as operations based on instructions derived from mark up language tags including the device requesting and responding to user commands, as required by claim 7.

Further, the display of an injectable component, which is the operation described in the identified text, is not "requesting and responding to user commands".

Accordingly, it is the position of the Applicants that claim 7 is new and unobvious over the Guthrie patent.

In view of the above, the conclusion is inescapable that the present invention as recited in the claims currently of record in the application is new and unobvious over the prior art references cited by the Examiner. Thus, withdrawal of the Examiner's rejection and allowance of the application is hereby respectfully requested.
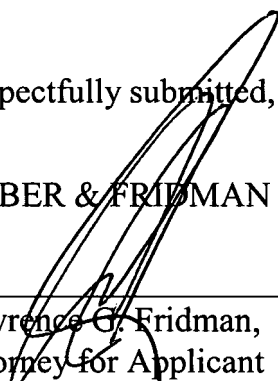
Applicants have made the best faith effort to place the above-referenced application in condition for allowance. However, if any issue raised by the PTO inadvertently remains unanswered, the Examiner is authorized to call the undersigned at the telephone number indicated hereinbelow.

Applicant respectfully petitions for a 3 month extension of time. A separate petition and credit card payment in the amount of $510.00 accompanies this Response.

Respectfully submitted,

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